

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-4, 8-13 17-19 and 38-41 are pending in the application, with claims 1, 11 and 38 being the independent claims. Claims 6-7 and 14-16 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. Claims 39-41 are sought to be added. Claims 1-4, 8-9, 11-13, 17 and 38 are amended herein. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn. Applicants believe that the amendments and remarks herein address each of the Examiner's rejection and make the claims allowable.

Rejections under 35 U.S.C. § 102

The Examiner rejected claims 1, 2 and 8 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,621,648 to Ivany ("the Ivany reference"). Applicants respectfully traverse this rejection. Applicants held an interview with Examiner on July 21, 2004 and discussed proposed amendments to the claims that would show how Applicants' shoe overcomes the prior art. The Examiner noted that specific claim language illustrating how the amount of hook and pile material in the Applicants' shoe differs from the prior art appears to be a favorable change. In particular, the Examiner suggested adding language directed towards the amount of said upper covered by hook and pile material, such as "50%" of the upper and indicated that the figures supported this type of amendment. The Examiner also appeared favorable to the language suggested by

Applicants' representative. As such, claim 1 has been amended as suggested by Applicants' representative to include that the portion of the upper with hook on one side and pile on the other "extends from a throat region of said upper to a region of said upper that attaches to said sole."

The Ivany reference does not teach a portion of hook on one side and pile on the other located in this area of the upper. Instead, the shoe of the Ivany reference recites that "[m]ale 'VELCRO' pads 32 and 34 are applied to the inside surfaces of straps A and B, respectively. In addition, a female 'VELCRO' pad 36 is applied to outside surface of strap A." Col. 5, lines 49-52. Further, the second embodiment also uses

female velcro 202 to cover all of the exposed portion of the ankle brace strap at least once it is positioned on the user's leg, plus enough of the portion covered by the outermost end of the ankle brace strip to enable a corresponding male velcro strip 204 positioned on the inside of the outermost end of the ankle brace strip to be removeably affixed thereto.

Col. 6, lines 33-39. As such, the only portions of the shoe of the Ivany reference to have hook on one side and pile on the other are strap A and an "outermost end of the ankle brace strap" in the second embodiment. The shoe described in the Ivany reference does not have any portion of hook and pile material that extends from the throat region of the upper to the region of the upper attached to the sole of the shoe. See Figure 5. As such, the Ivany reference does not teach each and every feature of the claimed invention.

Claims 2 and 8 depend from and add features to claim 1 and thus are patentable for the same reasons as claim 1.

In light of this amendment and the remarks above, Applicants respectfully request the withdrawal of this 35 U.S.C. § 102 rejection.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-4, 10-14, 19 and 38 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,486,965 to Friton ("the Friton reference") in view of U.S. Patent No. 5,744,080 to Kennedy ("the Kennedy reference"). Claims 1-3, 6, 10-12, 14, 15, 19 and 38 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,114,297 to Famolare, Jr. ("the Famolare reference") in view of the Kennedy reference. Claims 1-4, 8, 11-14, 17, 19 and 38 have been rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 4,969,277 to Williams ("the Williams reference") in view of the Kennedy reference. Claims 9 and 18 have been rejected under 35 U.S.C. § 103(a) as being obvious over the Williams and Kennedy references and further in view of U.S. Patent No. 5,176,624 to Kuehnreich ("the Kuehnreich reference"). Claims 10 and 38 have been rejected under 35 U.S.C. § 103(a) as being obvious over the Ivany reference in view of the Kennedy reference. According to the Examiner, it would be obvious to combine each of these references with the material taught by Kennedy to provide the hook and loop fastening materials. In fact, the Examiner has suggested "replacing materials, i.e. entire elements/regions/portions, with the material taught by Kennedy in the references of Friton, Famolare, and Williams." Office Action, pg. 6. Applicants respectfully traverse these rejections.

The background section of the Kennedy reference cited by the Examiner discusses prior techniques for bonding conventional (*i.e.* not back-to-back) pieces of Velcro to objects. However, the Kennedy reference is directed toward a back to back material. The Kennedy reference discusses the construction, utility and limitations of traditional back to back fasteners as follows:

Such a product is created by taking a hook fastener and a loop fastener and bonding the two together in a back to back relationship such that the resulting laminate has hooks on one side and loops on the other side. Such a combination finds wide use in many strapping operations such as wire ties, plant ties and fastener straps for holding splints and the like in place. The limitation of such products in the past has focused on the method used to laminate the two components together as described above. The bulk created by the adhesive bonding of such laminates has clearly limited its usefulness.

Col. 2, lines 52-62. The Kennedy reference suggests dealing with these limitations by "creat[ing] a loop surface on the back portion of the base of a plastic hook fastener which is capable of engaging into hooks on the front surface thereof to form a back to back laminate with less bulk, stiffness and thickness." Col. 3, lines 6-10. As such, the Kennedy reference only suggests replacing those portions that are comprised of traditionally bonded back to back hook and pile fasteners with a single-ply material. It does not suggest replacing locations of conventional (*i.e.* not back-to-back) hook and pile material, and it certainly does not suggest replacing entire sections or regions of footwear that contain *no* hook and pile material with a single-ply hook and pile material.

There are no sections in the Friton, Famolare, Williams or Kuehnreich references that consist of hook and pile material back to back. See Friton, Figure 3; Famolare, Figure 1; Williams, Figure 5 and Kuehnreich, Figure 1. Therefore, the Kennedy reference does not teach replacing anything in these references with single-ply material. Even if Kennedy could be read to teach replacing sections of conventional (*i.e.* not back-to-back) hook and pile material with the single-ply material, the resulting shoe would still not be the shoe as claimed.

During the July 21st interview, the Examiner agreed that the area covered by hook and pile material on Applicants' shoes differed from the prior art and suggested

amending the claims to reflect the coverage of hook and pile material on Applicants' shoes. Therefore, independent claims 1, 11 and 38 have all been amended as suggested to the Examiner to include a portion of hook and pile material that extends from the throat region of the upper to a region of the upper that is attached to the sole.

As can be seen in Figure 1 of the Friton reference, the hook and pile materials are located only in particular locations on upper 14 and do not extend from the throat region to a region of the upper that is attached to the sole, as independent claims 1, 11 and 38 have been amended to recite. Since the art alone or in combination does not teach this feature, independent claims 1, 11 and 38 are patentable over the combination of the Friton and Kennedy references. Claims 2-4 and 10 depend from and add features to claim 1, and claims 12-13 and 19 depend from and add features to claim 11. Therefore these claims are patentable for the same reasons that claims 1 and 11 are patentable. Claim 14 has been cancelled herein, rendering this rejection moot.

Furthermore, in the Famolare reference, the hook and pile pieces do not extend from the throat region and attach to the sole. The specification describes the pile material 20 as "a cooperating looped anchoring strip of 'Velcro' tape 20 *fixed on* the opposite side surface of upper 11." Col. 2, lines 14-16 (emphasis added). Since the pile material, 20, is "fixed on" the upper after the upper has been attached to the sole, the pile material itself cannot be attached to the sole. Therefore, claims 1, 11 and 38 are patentable over the combination of the Famolare and Kennedy references. Claims 2-3 and 10 depend from and add features to claim 1, and claims 12 and 19 depend from and add features to claim 11. Therefore these claims are patentable for the same reasons that claims 1 and 11 are patentable. Claims 6, 14 and 15 have been cancelled herein, rendering these rejections moot.

Similarly, the hook and pile pieces in the Williams reference do not extend from a throat region to a region attached to the sole. Instead, "[t]he pile portion 69 may be secured to the *forefoot portion* 55 of the second body member 19 and the hook portion 71 may be secured to the *forefoot portion* 43 of the first body member 17." Col. 3, lines 42-46 (emphasis added). The forefoot portions 55 and 43 in Figure 5 do not extend from a throat region to a region attached to the sole. Therefore, claims 1, 11 and 38 are patentable over the combination of the Famolare and Kennedy references. Claims 2-4, 8 and 10 depend from and add features to claim 1, and claims 12-13, 17 and 19 depend from and add features to claim 11. Therefore these claims are patentable for the same reasons that claims 1 and 11 are patentable. Claim 14 has been cancelled herein, rendering that rejection moot. Furthermore, because claims 9 and 18 depend from and add features to independent claims 1 and 11, respectively, they are therefore patentable for the same reasons that claims 1 and 11 are patentable.

Moreover, as stated in the above argument contesting the 35 U.S.C. §102(b) rejection, the Ivany reference does not have hook and pile material that attaches to the sole of the shoe and extends through the throat region, even in view of the Kennedy reference. Therefore, claims 10 and 38 are patentable over the combination of Ivany and Kennedy references.

In light of the amendments and the above remarks, Applicants' respectfully request the withdrawal of these 35 U.S.C. §103(a) rejections.

Other Matters

Applicants would like to thank the Examiner for her time and consideration during our interview on July 21, 2004.

Applicants respectfully submit that claims 1-4, 8-13, 17-19 and 38-41 are generic to all sub-species (A-D) defined by the Examiner in the Election Requirement dated May 22, 2002. Thus, upon allowance of one or more of these generic claims, Applicants respectfully request consideration of these claims as directed to the non-elected species and sub-species. Applicants assert the right to claim additional species in the event that a generic claim thereto is found to be allowable in accordance with 37 C.F.R. § 1.141(a).

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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